

## **REMARKS**

The June 22, 2004 Official Action has been carefully considered. In view of the amendments presented herewith and these remarks, favorable reconsideration and allowance of this application are respectfully requested.

At the outset it is noted that a shortened response period of three (3) months was set in the June 22, 2004 Official Action. The initial due date for response, therefore, was September 22, 2004. A petition for a one (1) month extension of the response period is presented with this amendment and request for reconsideration, which is being filed before the expiration of the one (1) month extension period.

In the June 22, 2004 Official Action, claim 82 stands rejected as allegedly indefinite, based on the recitations "a few millimeters thick". In addition, all of the claims currently under consideration, i.e. claims 43-94, stand rejected for obviousness-type double patenting, either non-provisional or provisional, based on the following patents and application: U.S. Patent No. 5,296,375 issued March 22, 1994; U.S. Patent No. 5,304,487 issued April 19, 1994; U.S. Patent No. 5,427,946 issued June 27, 1995; U.S. Patent No. 5,486,335 issued January 23, 1996; U.S. Patent No. 5,498,392 issued March 12, 1996; U.S. Patent No. 5,587,128 issued December 24, 1996; U.S. Patent No. 5,726,026 issued March 10, 1998; U.S. Patent No. 5,744,366 issued April 28,

1998; U.S. Patent No. 5,955,029 issued September 21, 1999; U.S. Patent No. 6,660,517 issued December 9, 2003; U.S. Patent No. 5,637,469 issued June 10, 1997; U.S. Patent No. 5,866,345 issued February 2, 1999; U.S. Patent No. 6,551,841 issued April 22, 2003; and copending U.S. Patent Application No. 10/348,438, filed January 21, 2003.

The foregoing rejections constitute all of the grounds set forth in the June 22, 2004 Official Action for refusing the present application.

In accordance with the present amendment the title has been amended to describe more aptly the subject matter set forth in the claims.

No new matter has been introduced into this application by reason of the amendment presented herewith.

For the reasons that follow, each of the grounds of rejection set forth in the June 22, 2004 Official Action, which are summarized above, are respectfully traversed.

**A. Claim 82 Fully Complies With The Definiteness Requirement of 35 U.S.C. §112, Second Paragraph**

The relevant inquiry in determining compliance, with the definiteness requirement of 35 U.S.C. §112, second paragraph, is whether the claim in questions sets out and circumscribes a particular area with a sufficient degree of precision and particularity, such that the metes and bound of the claimed

invention are reasonably clear. In re Moore, 169 U.S.P.Q. 236 (C.C.P.A. 1971).

The definiteness of claim language may not be analyzed in the abstract, but must be considered in light of the supporting specification, with the language in question being accorded the broadest reasonable interpretation consistent with its ordinary usage in the art. In re Morris, 44 U.S.P.Q.2d 1023, 1027 (Fed. Cir. 1997). See also Ex parte Cole, 223 U.S.P.Q. 94 (Bd. Apps. 1983) (claims are addressed to the person of ordinary skill in a particular art; compliance with §112 must be adjudged from that perspective, not in a vacuum).

Furthermore, it has long been held that the initial burden of establishing a failure to comply with 35 U.S.C. §112, second paragraph, rests upon the Examiner. In rejecting a claim for alleged indefiniteness, therefore, it is incumbent upon the Examiner to establish that one having ordinary skill in the art would not have been able to ascertain the scope of protection defined by the claim when read in light of the supporting specification. Ex parte Cordova, 10 U.S.P.Q.2d 1949, 1952 (PTO B.P.A.I. 1988).

When the appropriate procedural approach is followed in assessing the claim terminology at issue, in accordance with the above-noted authorities, it is beyond question that applicants have satisfied the definiteness requirement of §112, second

paragraph, with respect to the subject matter of claim 82.

When the claim recitation "a few millimeters thick" is accorded its ordinary and accustomed meaning, claim 82 cannot reasonably be considered indefinite. The word "few", when used as an adjective (as in claim 82) is commonly understood to refer to a small number and would be so understood by those of ordinary skill in the field of the present invention. In the context of claim 82, "a few millimeters thick" would be interpreted by those of ordinary skill in the art as denoting that the thickness of the first substrate is a small number of millimeters. Accordingly, those of ordinary skill in the art would have a clear appreciation of what claim 82 would preclude one from doing in future enterprise. See, Ex parte Ohsumi, 21 U.S.P.Q.2d 1020 (PTO B.P.A.I. 1991). The conclusion is inescapable, therefore, that the recitation of "a few millimeters thick" does not render claim 82 indefinite.

It is noteworthy in this regard that the U.S. Patent and Trademark Office (PTO) has issued in excess of 4,000 patents in which the word "few" appears in at least one claim. For example, claim 2 of U.S. Patent No. 6,793,978 and claim 15 of U.S. Patent No. 6,790,972 refer to a time period of "a few minutes". Claim 11 of U.S. Patent No. 6,793,736 refers to a distance of "a few mean-free-path lengths". Claim 1 of U.S. Patent No. 6,789,539 refers to a safety margin of "a few percent". Claim 10 of U.S.

Patent No. 6,784,088 refers to a thickness of "from a few tens to a few thousands of Angstroms". Claim 6 of U.S. Patent No. 6,783,630 refers to a distance which is "greater than about a few microns". This is but a small fraction of the total number of patents issued by the PTO in which the word "few" appears in the claims.

Given that the PTO has allowed such a multitude of claims including the word "few", the present rejection of claim 82, based on alleged indefiniteness, directly contravenes fundamental principles of justice and fair dealing. Applicants in the present case should not be held to a more rigorous standard with respect to satisfying the definiteness requirement of 35 U.S.C. §112 than were the applicants in the over 4,000 issued U.S. patents including claims that recite the word "few". For this reason also, the 35 U.S.C. §112, second paragraph rejection of claim 82 should be withdrawn.

In summary, applicants position with respect to the rejection of claim 82 based on 35 U.S.C. §112, second paragraph, is that any person of ordinary skill in the art, having applicants' disclosure and claims before him or her, would be apprised to a reasonable degree of certainty as to the exact subject matter encompassed within claim 82. Nothing more is required under 35 U.S.C. §112, second paragraph.

For all of the foregoing reasons, it is clear that in the

present case, the Examiner has failed to satisfy his burden of proof with respect to the §112, second paragraph, rejection of claim 82, as set forth in the June 22, 2004 Official Action. Accordingly, this ground of rejection is improper and should be withdrawn.

**B. The Various Obviousness-Type Double Patenting  
Rejections Of the Present Application Are Unwarranted  
And Cannot Be Maintained In Any Case In View Of The  
Terminal Disclaimer Submitted Herewith**

The obviousness-type double patenting rejections set forth in the June 22, 2004 Official Action are unwarranted for a number of reasons.

First, in at least one instance the examiner mischaracterizes patent claims cited in support of the obviousness-type double patenting rejections. Specifically, U.S. Patent 5,427,946 is described in the June 22, 2004 Official Action as claiming a mesoscale fluid handling device. That is simply not the case. All of the claims of the '946 patent are directed to a device for in vitro fertilization of an egg. The claimed device is adapted for a specific use and requires the presence of an egg. Such claims certainly do not render obvious the claims of the present application, which are drawn to a mesoscale fluid handling device. This is true, irrespective of the subject matter disclosed in the specification of the '946

patent.

Furthermore, with regard to the numerous other patents and the patent application cited in support of these rejections, there is no potential for unjustified or improper patent term extension.

According to §804 of the Manual of Patenting Examining Procedure, an obviousness-type double patenting rejection is grounded in public policy, so as to prevent the unjustified or improper time-wise extension of the right to exclude granted by a patent. In this case, however, there is no opportunity for unjustified or improper time wise extension of applicants' exclusive patent rights. The present application, as well as the other patents and the patent application on which these rejections are based all have the same effective filing date. Thus, if a patent were granted on this application, the patent term of such patent would expire on the same date as the other patents on which these rejections are based. That being the case, there is no justification for an obviousness-type double patenting rejection in this application.

In addition to the above reasons, the various obviousness-type patenting rejections set forth in the June 22, 2004 Official Action cannot be maintained in view of the attached terminal disclaimer which is being submitted pursuant to 35 U.S.C. §253 and 37 C.F.R. §1.321(b) and (c).

This terminal disclaimer makes reference to the following

U.S. patents and patent application: U.S. Patent No. 5,296,375 issued March 22, 1994; U.S. Patent No. 5,304,487 issued April 19, 1994; U.S. Patent No. 5,486,335 issued January 23, 1996; U.S. Patent No. 5,498,392 issued March 12, 1996; U.S. Patent No. 5,587,128 issued December 24, 1996; U.S. Patent No. 5,726,026 issued March 10, 1998; U.S. Patent No. 5,744,366 issued April 28, 1998; U.S. Patent No. 5,955,029 issued September 21, 1999; U.S. Patent No. 6,660,517 issued December 9, 2003; U.S. Patent No. 5,637,469 issued June 10, 1997; U.S. Patent No. 5,866,345 issued February 2, 1999; U.S. Patent No. 6,551,841 issued April 22, 2003; and copending U.S. Patent Application No. 10/348,438, filed January 21, 2003.

The terminal disclaimer submitted herewith does not make reference to U.S. Patent 5,427,946, because the obviousness-type double patenting rejection based thereon is improper for the reason given above.

The law is well settled that a timely filed terminal disclaimer under 35 U.S.C. §253, which satisfies the requirements of 37 C.F.R. §1.321(b) and (c), will overcome an obviousness-type double patenting rejection.

In view of the terminal disclaimer submitted herewith, as well as above-noted distinction between the claims of this application and the claims of the '946 patent, the various obviousness-type double patenting rejections of claim 43-94, as



set forth in the June 22, 2004 Official Action, are untenable and should be withdrawn.

In view of the foregoing remarks and the terminal disclaimer submitted herewith, it is respectfully requested that the rejections set forth in the June 22, 2004 Official Action be withdrawn and this application be passed to issue, and such action is earnestly solicited.

DANN DORFMAN HERRELL and  
SKILLMAN, P.C.

Attorneys for Applicant

By Patrick J. Hagan  
Patrick J. Hagan  
Registration No. 27,643

PJH:cmb  
Enclosure: Terminal Disclaimer and fee